

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

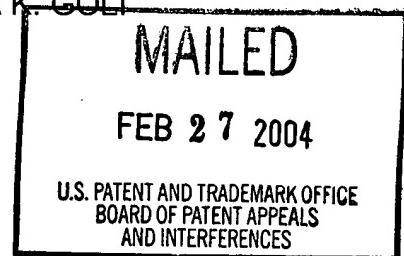
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JENNIFER L. HILLMAN and SURYA K. GOLI

Appeal No. 2002-1343
Application No. 09/207,161

ON BRIEF



Before WILLIAM F. SMITH, GRIMES and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

REMAND TO THE EXAMINER

This case is remanded to the examiner to clarify the status of the references cited the Brief on Appeal.

Appellants cited four references on pages 18 and 19 in the Brief on Appeal: the Steiner reference, the Rockett (Xenobiotica 29(7): 655, 656 (1999)) reference, the Nuwaysir reference and the Rockett (Environ. Health Perspec. 107(8)681 (1999)). The Examiner's Answer does not acknowledge the references and also does not comment on the references in the substance of the

answer. Thus, it is unclear if those four references constitute part of the record on appeal.¹

We note that under 37 CFR § 1.195, “[a]ffadavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented.” If the four references have not been entered, the examiner should make an explicit statement on the record so stating, and also stating the reasons as to why the references have not been admitted. If the references have been entered, again the examiner should make an explicit statement on the record so stating. If the references have been entered, we authorize the examiner to file a Supplemental Examiner’s Answer limited to the issues those references raise. In this regard, we direct the examiner’s attention to sections 716.01 (“When the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as ‘the declaration lacks technical validity’ or ‘the evidence is not commensurate with the scope of the claims’ without an explanation supporting such findings are insufficient.”), 716.08, and 2107-2107.03 of the MPEP. If a Supplemental Examiner’s Answer is filed, Appellants are entitled to file a Supplemental Reply Brief. See 37 CFR § 1.193(b)(1).

¹ We note that these references were also cited in appellants’ response to the office action dated April 14, 2000. See Paper No. 14, pages 8-9. Our review of the record, however, did not uncover an information disclosure statement on which those references had been listed and initialed off by the examiner, nor did the examiner’s final rejection mailed in response to that paper address the references.

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01. It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

William F. Smith
William F. Smith
Administrative Patent Judge

Eric Grimes
Eric Grimes
Administrative Patent Judge

Lora M. Green
Lora M. Green
Administrative Patent Judge

)
) BOARD OF PATENT
)
) APPEALS AND
)
) INTERFERENCES
)

INCYTE GENOMICS, INC.
3160 Porter Drive
Palo Alto, CA 94304